

REMARKS

This is a simultaneous amendment for a request for continued examination filed under 37 C.F.R. 1.114 in response to the final Office Action dated January 24, 2008.

I. OBVIOUSNESS REJECTION

Amended claims 10 to 15 were rejected as obvious under 35 U.S.C. 103 (a) over Abraham, et al, WO 02/36314 A1 (referred to as "Abraham" herein below), in view of Hildebrandt (German Patent 33 107 06 A1).

The "response to argument" in paragraph 3 on pages 3 to 4 of the Office Action stated that not enough structural limitations were included in independent haircutting machine claim 10 to distinguish that claimed haircutting machine from the haircutting machines suggested by the combination of the disclosures of Abraham and Hildebrandt.

In response the previously pending independent claim 10 has been canceled.

New independent haircutting machine claim 16 has been filed, which replaces the canceled claim 10. The new independent claim 16 includes all the limitations of claim 10 and additional limitations that distinguish its subject matter from the combination of Abraham and Hildebrandt. The dependent claims 11 to

15 have been amended so that they now depend on the new independent claim 16.

The critical differences between the haircutting machines of the present invention and those of the prior art are best understood by studying either figs. 5 and 6 or figs. 14 to 16. In the case of the applicants' haircutting machines the stationary blade 18 is always arranged between the oscillating blade 20 and the handle 12 in which the drive motor is mounted. The drive shaft for the drive motor extends through the stationary blade 18 to engage the oscillating blade 20, as shown in fig. 15 particularly. The detailed mechanism for accomplishing this unconventional drive arrangement is described on page 9, line 21, to page 10, last line, especially page 9, lines 27 to 30, of the applicants' originally filed specification.

In contrast, figs. 4 to 8 of Abraham clearly show that the oscillating blade 57 is arranged between the stationary blade 55 and the remaining part of the cutter head or handle. In the case of this arrangement an eccentric drive shaft or the like does not extend through the stationary blade, as in the case of the applicants' arrangement. However the arrangement of Abraham is clearly the opposite from the applicants' arrangement in which the oscillating blade is arranged "on top of" the stationary blade in the operating position, i.e. in which the stationary blade is arranged between the oscillating blade and the handle, so that elements that drive the oscillating blade extend through the stationary blade.

The secondary reference, DE 3310706 A1 (DE '706), shows and describes a conventional mechanism for driving an oscillating blade in the head

of an electric haircutting machine in which the motor is mounted in the handle. According to DE '706 their oscillating blade 16 is arranged between the handle and their stationary blade 2 as shown in fig. 2 (the only embodiment described in detail in DE '706). This is the opposite arrangement according to applicants' claimed invention according to new claim 16, in which the stationary blade is arranged between the oscillating blade and the handle.

The last paragraph of new claim 16 is as follows:

“the electric drive unit (54) contained in the handle (12) is connected to the oscillating blade (20) through the stationary blade (18) in order to drive the oscillating blade and the stationary blade (18) is arranged between the oscillating blade (20) and the handle (12)”.

In fact, applicants' claim 16 contains two limitations in this paragraph that distinguish the claimed subject matter from the combined disclosures of Abraham and Hildebrandt. The first is that the stationary blade is arranged between the oscillating blade and the handle and the second is that the electric drive unit is connected to the oscillating blade through the stationary blade to drive the oscillating blade.

A valid rejection under 35 U.S.C. 103 (a) of a claimed invention cannot be justified by prior art disclosures that include teaching of the opposite from the claimed invention. The obviousness rejection of the canceled claim 10 that is supported by the disclosures of Abraham and Hildebrandt should not be applied to the new claim 16, which contains the above-described additional distinguishing limitations so that claim 16 now claims the opposite structure from that of Abraham and Hildebrandt.

For example, see M.P.E.P. 2145. X. D. Also note that the Federal Circuit Court of Appeals has said:

“A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered.”
Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416 (Fed. Cir. 1986)

The foregoing difference in the positions of the oscillating blade and the stationary blade relative to the handle leads to an important difference in the manner in which hair can be cut by the haircutting machine of the invention and the prior art machine. This is explained on page 2, lines 10 to 20, of the applicant’s specification, where it states the following:

“With the handle of the hair cutting machine in the operating position, because the cutting plane is inclined downward in relation to the longitudinal axis of the handle, with the oscillating blade disposed above the stationary blade, the oscillating blade on the cutter head of the hair cutting machine is oriented so that the oscillating blade....continuously guide strands of hair into the stationary blade, which produces a fine, dense thinning of hair.... achieving a cutting result with a hair cutting machine equal to that of a scissors cut.”

The specification goes on to state on page 2, lines 21 to 24, that:

“One advantage of the hair cutting machine according to the present invention is that it can mechanically produce a haircut that gives a visual impression similar to that of the classic scissors cut without the danger of injury to the scalp.”

Furthermore the angular range that the cutting plane encloses in relation to the axis of the handle for the hair cutting machine in claim 16 differs from that of Abraham. This limitation is found in about lines 11 to 12 of applicants’ claim

16. The angular range for the hair cutting machine of Abraham the angle α is in a range from -45° to -90° , whereas according to claim 16 the angle α is positive and in a range from 0 to 90° .

The secondary reference, Hildebrandt, does not disclose or suggest the modifications of the disclosures of Abraham that will lead to the invention as claimed in applicants' claim 16.

It is well established by many US judicial opinions that to reject a claimed invention under 35 U.S.C. 103 there must be some hint or suggestion in the prior art of the modifications of the disclosures, which are necessary to arrive at the claimed invention, in the prior art reference or references used to reject the claimed invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2nd 1313 (Fed. Cir. 2000). See also M.P.E.P. 2141

Hildebrandt does not disclose or suggest the modifications of Abraham that are necessary to arrive at the claimed invention. Also Hildebrandt teaches the opposite from the claimed invention like Abraham.

It is respectfully submitted that new claim 16 and amended claims 11 to 15 should not be rejected under 35 U.S.C. 103 (a) over Abraham, et al, WO

02/36314 A1 (referred to as "Abraham" herein below), in view of Hildebrandt
(German Patent 33 107 06 A1).

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,



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